

## REMARKS

Applicant has carefully reviewed the office action mailed August 25, 2006 and offers the following remarks to accompany the above amendments.

Claims 1-4, 6-16, 19-32, 34, and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,901,359 to Malmstrom (hereinafter "Malmstrom") in view of U.S. Patent No. 6,154,650 to Abidi et al. (hereinafter "Abidi"). Applicant respectfully traverses. To establish *prima facie* obviousness, the Patent Office must show where each and every element of the claim is taught or suggested in the combination of references. For the Patent Office to combine references in an obviousness rejection, the Patent Office must prove there is a suggestion to combine the references. For the Patent Office to prove that there is a suggestion to combine the references, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Before addressing the current rejections, Applicant provides a brief summary of the present invention so that the remarks are considered in the proper context. The present invention is designed to allow a single mobile terminal to move between a cordless mode and a cellular mode. In the cordless mode, the mobile terminal uses a terminal adaptor which, as defined in paragraph 0004, is capable of communicating wirelessly with the mobile terminal. In this manner, a customer may have a single mobile terminal yet operate in both a wireline mode and a wireless mode. Operation in the wireline mode does not require the mobile terminal to be connected to the wireline network via a wire since the mobile terminal communicates with the terminal adaptor wirelessly. The mobile terminal has a single phone number, and regardless of where the mobile terminal is located, calls directed to the single phone number are routed to the mobile terminal through the appropriate network. In the preferred embodiment, the calls are directed to the wireline system first, so as to avoid charges associated with use of the cellular network. Only if the mobile terminal is not available on the wireline network is the call routed to the wireless network.

Claims 1 and 19 have been amended to clarify that when determining that the incoming call should be routed via the terminal adaptor, the wireline switch is instructed to route the

incoming call to the mobile terminal via the terminal adaptor using only the directory number for which the incoming call was originally intended and which is supported by the wireline switch. Support for this amendment may be found in at least paragraphs 0004, 0026, and 0028 of the Specification, as well as Figure 3. No new matter has been added.

Claim 1 as amended reads:

A method comprising:

a) determining whether to route an incoming call intended for a directory number supported by a wireline switch to a mobile terminal via a terminal adaptor operatively associated with the wireline switch or to the mobile terminal via a cellular network;

b) when determining the incoming call should be routed via the terminal adaptor, instructing the wireline switch to route the incoming call to the mobile terminal via the terminal adaptor using only the directory number; and

c) when determining the incoming call should be routed via the cellular network, instructing the wireline switch to route the incoming call to the mobile terminal via the cellular network using a temporary routing indicia, which is temporarily associated with the mobile terminal to facilitate routing the incoming call to the mobile terminal via the cellular network.

The Patent Office admits that Malmstrom does not teach determining whether to route an incoming call intended for a directory number via a terminal adaptor, and instructing the wireline switch to route the call to the mobile terminal via the terminal adaptor (Office Action mailed August 25, 2006, p. 3). The Patent Office then asserts that this element is found in Abidi, and in particular, equates the cordless base station in Abidi to the claimed terminal adaptor. *Id.*

However, in contrast to the present invention, Abidi does not teach or suggest wherein the incoming call is routed to the mobile terminal via the terminal adaptor using only the directory number for which the incoming call was originally intended that was supported by the wireline switch. In Abidi, the mobile station and the cordless base station each have a different directory number (Abidi, Abstract). When the cordless base station senses that the mobile station is within radio range, it initiates a short call in order to inform the HLR to change its location information such that calls having the directory number are routed to the directory number of the cordless base station (Abidi, col. 3, line 63 through col. 4, line 1). Thus, when a caller dials the directory number of the mobile station, the servicing MSC receives the wireline directory number of the cordless base station and uses that to route the call to the mobile station

(Abidi, col. 4, lines 7-15). Based on the above, it is clear that Abidi uses both the directory number of the mobile terminal and the directory number of the cordless base station in routing a call to the mobile terminal. Accordingly, Abidi does not teach or suggest wherein the incoming call is routed to the mobile terminal via the terminal adaptor using only one directory number, the directory number that the call was originally intended for and that is supported by the wireline switch, as required by amended claims 1 and 19. Thus, the combination of Abidi and Malmstrom does not teach or suggest each and every element of claims 1 and 19, and therefore, claims 1 and 19 are allowable.

Claims 5 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malmstrom in view of Abidi and further in view of U.S. Patent No. 6,496,691 B1 to Easley et al. (hereinafter “Easley”). Applicant respectfully traverses. The standards for obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation is “for the serving MSC to inform the home location register temporary routing information on how the incoming call should be routed to the mobile station within the wireless network. . .” (Office Action of August 25, 2006, p. 5). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation to combine the references is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 5 and 33 on this basis.

Even if the combination is proper, a point which Applicant does not concede, the combination does not teach or suggest each and every element of the claimed invention. As explained above, the combination of Malmstrom and Abidi does not teach or suggest wherein the incoming call is routed to the mobile terminal via the terminal adaptor using only the directory number for which the incoming call was originally intended and that was supported by the wireline switch. Easley does not cure the deficiencies of Malmstrom and Abidi. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each

and every element of the claimed invention, the combination does not establish obviousness. Since the combination does not establish obviousness, claims 5 and 33 are allowable.

Claims 17 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malmstrom in view of Abidi and further in view of U.S. Patent No. 7,043,248 B2 to Hallenstål et al. (hereinafter “Hallenstål”). Applicant respectfully traverses. The standards for obviousness are set forth above.

Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation is “for the wireline system to become a cordless telephone system wherein a cordless handset could communicate using short range communication with a cordless base station when receiving an incoming call . . .” (Office Action of August 25, 2006, p. 6). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation to combine the references is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of claims 17 and 35 on this basis.

Even if the combination is proper, a point which Applicant does not concede, the combination does not teach or suggest each and every element of the claimed invention. As explained above, the combination of Malmstrom and Abidi does not teach or suggest wherein the incoming call is routed to the mobile terminal via the terminal adaptor using only the directory number for which the incoming call was originally intended and which is supported by the wireline switch. Hallenstål does not cure the deficiencies of Malmstrom and Abidi. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each and every element of the claimed invention, the combination does not establish obviousness. Since the combination does not establish obviousness, claims 17 and 35 are allowable.

Claims 18 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malmstrom in view of Abidi and further in view of International Publication No. WO 02/19750 A1 to Hallensål (hereinafter “Hallensål ‘750”). Applicant respectfully traverses. The standards for obviousness are set forth above.

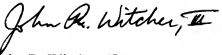
Applicant initially traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts that the motivation is “for the wireless network to operate at a particular frequency band for its mobile subscribers. . .” (Office Action of August 25, 2006, p. 6). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation to combine the references is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper. Since the rejection is improper, the Patent Office has not established obviousness, and claims 18-38 are allowable.

Even if the combination is proper, a point which Applicant does not concede, the combination does not teach or suggest each and every element of the claimed invention. As explained above, the combination of Malmstrom and Abidi does not teach or suggest wherein the incoming call is routed to the mobile terminal via the terminal adaptor using only the directory number for which the incoming call was originally intended and which is supported by the wireline switch. Hallensål ‘750 does not cure the deficiencies of Malmstrom and Abidi. Since the references individually do not teach or suggest the claim element, the combination of references cannot teach or suggest the claim element. Since the combination does not teach or suggest each and every element of the claimed invention, the combination does not establish obviousness. Since the combination does not establish obviousness, claims 18 and 38 are allowable.

The present application is now in condition for allowance and such action is respectfully requested. The Examiner is encouraged to contact Applicant’s representative regarding any remaining issues in an effort to expedite allowance and issuance of the present application.

Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By: 

John R. Witcher, III  
Registration No. 39,877  
P.O. Box 1287  
Cary, NC 27512  
Telephone: (919) 654-4520

Date: November 27, 2006  
Attorney Docket: 7000-268